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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,321	11/03/2005	Hisashi Aoki	280527US6PCT	3930
22850	7590	03/19/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER DIAO, M BAYE	
			ART UNIT	PAPER NUMBER
			2838	
			NOTIFICATION DATE	DELIVERY MODE
			03/19/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/555,321	Applicant(s) AOKI ET AL.	
	Examiner M'BAYE DIAO	Art Unit 2838	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/30/2008</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Acknowledgement is made of Amendment filed on 12/15/2008.
2. Claims 1,3-23 are still pending in the application.

Information Disclosure Statement

1. The information disclosure statement (IDS) filed on 10/30/2008 has been considered and placed of record. An initialed copy is attached herewith.
2. **Claims 1, and 3-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tohya et al., (Tohya) US PAT 4,636,703 in view of Patino US 20050200331.**
3. As per claims 1, 5, 8, and 11, Tohya et al. disclose (col. 1, ls. 40+; col. 2, ls. 3+ ;col. 3, ls. 55+; col. 4, ls. 1-57; col. 5, ls. 1-27) and show in Figs. 1A-B,2-4,8, and 12A-C:

A battery device housed in a single battery housing chamber (50) (which is defined by the frame structure (1) and the casing (3), see col. 5, lines 34-38) of an electronic device, comprising

a case (1) having side surfaces located on both ends of a width direction (see Figures 2-3), an upper surface (top of casing (3)) and lower surface (bottom of casing (3), since (3) is part of the battery housing chamber (50)) located on both ends of a thickness direction (height of frame (1)), and a front surface (33) (see Fig. 1A) and a rear surface (see Figs. 2-3) located on both ends of a length direction; a charging unit (not shown, see col. 5, ls. 1-20) disposed inside the case (3) (since (3) is part of the housing chamber (50)); and a battery side terminal ((13A,13B,14A,14B, or 36A, 36B

Art Unit: 2838

see Fig. 1B) or (34A,34B,35A,35B,or 36A, 36B see Fig. 1B) disposed on the front surface (33) of the case (1 or 3) and connected to the charging unit (not shown); wherein

a first engaging recessed part (16) is formed on the side (instead of front) surface of the case (1)(see4 Fig. 1A) of the second battery device (102 or 104) and a second engaging recessed part (16) is formed on the side (instead of front) surface of the case (1) (see Figs. 1A & 4) of the battery device, the first and second engaging recessed parts being separated in the width direction by a gap (see Fig. 1A);

Tohya differs from the claimed invention because he does not specifically disclose, the battery side terminal configured to connect to a housing chamber side terminal of the electronic device to provide electric power to the charging unit from the electronic device as said charging unit charges and to provide electric power from the charging unit to the electronic device through the battery side terminal as the charging unit discharges. Tohya kept silent about it.

Patino discloses ([0022]) a battery (112) suitable for receiving a charging current via a charging unit (110) and providing electric power to an electronic device, such as a cellular telephone, two ways radio, or a personal digital assistant.

Tohya et al. when combined with Patino discloses the claimed invention except for the recessed part being formed on the side surface instead of the front. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to dispose a battery side terminal on the front of the case and connected to the

Art Unit: 2838

charging unit wherein a first engaging recessed part is formed on the front surface of the case of the battery device and a second engaging recessed part is formed on the front surface of the case of the battery device, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Accordingly, claims 1, 5 & 8, 6, 11, and 20-23 would have been obvious.

4. As per claims 3 and 12, Tohya discloses (col. 3, ls. 55+; col. 4, ls. 10-12) and shows in Fig. 1A that the battery device according to claim 1, wherein the battery device (101 or 103 or 102 or 104) device comprises a frame (1) and a film (resin) attached to portions of the frame excluding a front and back side portions of the frame (since the recesses are attached on the side of the case (3), obviously they will exclude the front and back portions of the frame).

Accordingly, claims 3 and 12 would have been obvious.

5. As per claims 4 and 13, Tohya discloses (col. 4, ls. 1-51) and shows in Fig. 1A that the battery device according to claim 3, wherein the film (resin) is attached to the frame (1) so as to wrap around the entire circumference excluding the front and back side portions of the frame (since the recesses are attached on the side of the case (3), impliedly they will exclude the front and back portions of the frame); and the battery device further includes slant parts(15) disposed on side surfaces of the frame (1), which correspond to the side surfaces of the case (3)(as shown in Fig. 1A), each of the slant parts facing toward the side surface of the frame (1) (instead of the front or back side of the frame (1)), an amount of protrusion (18) from the frame being increased starting from the middle position in the length direction of the frame (1) to the

Art Unit: 2838

front (opened section since the frame is in a form of U shaped, see Fig. 1A below) or back side portion (11) of the frame (1), the slant part making continuous connection to the front and back side portion.

Tohya when combined with Patino discloses the claimed invention except for the slant parts facing toward the side surface of the frame (1) instead of the front or back side of the frame (1). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to dispose the slant parts facing toward the front or back side of the frame (1), since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Accordingly, claims 4 and 13 would have been obvious.

6. As per claims 7, and 9-10, Tohya et al. when combined with Patino discloses (see Fig. 4) the battery device wherein the first recessed engaging part (16)(on both sides, as shown in Figs. 1A & 4) is formed above the battery (103) terminal (14A, 14B) (see Fig. 1A).

7. Accordingly, claims 7 and 9 - 10 would have been obvious.

8. As per claims 14 - 15, 17, and 19 Tohya et al. when combined with Patino discloses (col. 3, lines 55+; col. 4, lines 1-33) and shows in Fig. 1A, that the engaging means (15) extends to a first side and second side surface (pair of arm plates (12)) of the case (frame structure (1)).

Accordingly, claims 14-15, 17, and 19 would have been obvious.

9. As per claim 16, Tohya et al. when combined with Patino discloses (see Fig. 4) the battery device wherein the first recessed engaging part (16)(on both sides, as

Art Unit: 2838

shown in Figs. 1A & 4) is formed above the battery (103) terminal (14A, 14B) (see Fig. 1A).

Accordingly, claim 16 would have been obvious.

10. As per claim 18, Tohya et al. when combined with Patino discloses (col. 3, lines 55+; col. 4, lines 1-33) and shows in Fig. 1A, that the engaging means (15) extends to a first side and second side surface (pair of arm plates (12)) of the case (frame structure (1)).

Response to Arguments

11. Applicant's arguments filed 12/15/2008 have been fully considered but they are not persuasive to overcome the rejections of Tohya in view of Patino.

12. Applicant argues that modifying the charging circuit within power supply casing (3) of Tohya as suggested by the proposed combination would be a substantial redesign of the device described in Tohya. Such a modification is contrary to well settled case law which holds that if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the *claims prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

13. Examiner respectfully disagrees and submits that such a combination would be as simple as providing a housing with a power supply charging as taught by Tohya inside the charging circuit of Patino, and that does not require undue redesign.

Art Unit: 2838

14. The deficiency in Tohya has been cured by Patino because the rechargeable battery (112) is suitable for receiving charge via charging circuit (110) and provides power (by discharging) to an electronic device as disclosed (see [0022]) by Patino.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M'BAYE DIAO whose telephone number is (571)272-6127. The examiner can normally be reached on 8:30-5:00; First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Akm Ullah can be reached on 571-272-2361. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2838

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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